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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/594,734

09/29/2006

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4710-0139PUS1

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

NOTIFICATION DATE

DELIVERY MODE

04/13/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/594,734 | Applicant(s) SAKUTA, KOJI | |
| | Examiner DANIELLE SULLIVAN | Art Unit 1616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/29/2006 and 12/11/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-12 and 14-36 are pending examination. Claims 13 was cancelled in the amendment filed 12/18/2008.

Election/Restrictions

Applicant's election with traverse of Group III in the reply filed on 12/18/2008 is acknowledged. The traversal is on the ground(s) that applicant's amendments to the claims cause all pending claims to share unity of invention. In view of applicants amendments the restriction requirement had been removed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

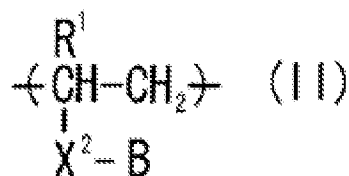
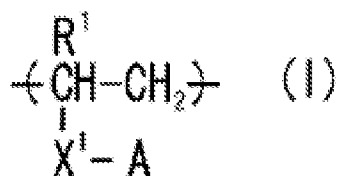
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 and 14-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the following:

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1. **(Currently Amended)** A cosmetic comprising (A) a polymer having repeating units represented by the following formulas (I) and (II):

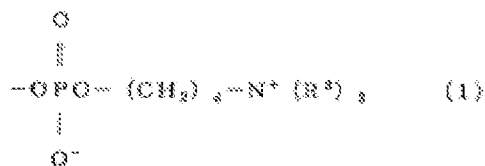


wherein each R^1 may be the same with or different from each other and is a hydrogen atom or a methyl group,

each of X^1 and X^2 has 2 to 10 carbon atoms and is a divalent aromatic group or a group represented by the formula, -COOR^7 , wherein R^7 is an aliphatic group bonded to A or B,

A is an organopolysiloxane residue, and

B is a group represented by the following formula (1),



wherein each R^3 may be the same or different from each other and is an alkyl group having 1 to 20 carbon atoms and d is an integer of from 1 to 10, and (B) an unctuous agent.

It is unclear by the disclosure how (I) and (II) are attached. Formula (I) and (II) may be attached directly to each other or be intervening groups which appear in a

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polymer chain. Hence, the claims are confusing and the metes and bounds of what polymer structure (A) encompasses is not disclosed.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 and 14-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The factors considered in the Written Description requirement are (1) *level of skill and knowledge in the art*, (2) *partial structure*, (3) *physical and/or chemical properties*, (4) *functional characteristics alone or coupled with a known or disclosed correlation between structure and function*, and the (5) *method of making the claimed invention*.

While all of the factors have been considered, only those required for a *prima facie* case are set forth below.

In the instant case, the claims are drawn to a cosmetic comprising (A) a polymer having repeating units represented by formulas (I) and (II) above.

(2) Partial structure:

Formula (I) and formula (II) are separate portions of polymer (A). The specification also teaches an additional repeating group (III) derived from at least one

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radically polymerizable monomer (page 9, lines 1-7). The specification states that examples of monomers for preparing the repeating units (I) are those represented by formula (5) and (6) (page 11, line 19 through page 12, line 3). However, polymer (A) is not explicitly defined. Polymer Structure, 2003 states there are many ways a monomers of a polymer can be arranged and further states that copolymers may be branched, random, block or graft in their structure.

There are no examples of structures within the specification which specify polymer (A). Examples only recite the monomers (I) and (II), not the structure obtained. The specification fails to exemplify the structure of any of the numerous polymer formations which formula (I), (II) and (III) may form. Therefore, the written description requirement has not been satisfied.

Weighing all the factors, one of ordinary skill in the art would not recognize from the disclosure that the applicant was in possession of a cosmetic comprising (A) a polymer having repeating units represented by formulas (I) and (II) above.

Therefore, the written description requirement is not satisfied.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Danielle Sullivan
Patent Examiner
Art Unit 1616

/Johann R. Richter/
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